



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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4/23/02

In re application of: Posa et al.

Serial No.: 09/470,452 ✓

Group No.: 1771 ✓

Filed: Dec. 22, 1999 ✓

Examiner: H. Vo ✓

COPY OF PAPERS
ORIGINALLY FILED

For: TAPE AND WRAPPING MATERIALS WITH EDGE-FINDING FEATURE

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

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APR 15 2002
TC 1700

In response to the Office Action mailed December 31, 2001, the claims of this application are being resubmitted in unamended form for reconsideration in view of the following remarks.

Claim 9-10, 13, 15, 16 and 18 stand rejected under 35 U.S.C. §102(b) or, in the alternative, under §103 over Fusselman ('482), submitted by Applicants. The Examiner wishes to point out that the phrase "visually apparent" does not necessarily mean the same thing as "visually distinct from the non-edge area of the tape." However, Applicants would like to point out that claim 9 includes language to the effect that when the tape is cut or torn to produce a newly-formed edge, the edge becomes visually apparent, thereby assisting a user in finding the edge when overlaid on the roll. Thus, though Applicants did not use the exact wording suggested by the Examiner, to have an edge which becomes visually apparent when overlaid on a roll clearly implies, if not explicitly recites an edge which is "visually distinct from the non-edge area of the tape."

The Examiner concedes that "Fusselman is silent as to a newly formed edge that becomes visually apparent when the tape is cut or torn." This statement alone should preclude anticipation or obviousness. Still, "it is the Examiner's position that the adhesive tape of Fusselman would inherently

form the same new edge when the tape is or torn as the edge-indicating tape of the present invention.” This statement has no support. There is nothing “inherent” about the Fusselman reference meeting the limitations of Applicants’ claims. Indeed, the tape of Fusselman simply includes “a color” within a film in the form of “a standard cellulose acetate” (see col. 1, line 48 and col. 2, lines 56-57). As such, Applicants disagree that “the edge formation as claimed would obviously have been provided.” Rather than relying on opinion and supposition, Applicants respectfully request that the Examiner cite actual references with teachings or disclosures related to Applicants’ claims, and if such evidence does not exist, the claims should simply be allowed.

Although the Examiner rejected claims 9-10, 13, 15, 16 and 18 under §102, no substantive remarks or arguments are provided by the Examiner with respect to claim 15, which is also independent. This claim includes the limitation of a fluorescent material being operative to absorb light of a first wavelength and emit light of a second wavelength, etc. It is well-settled that, in order to anticipate, a cited reference must teach *each and every element* of an invention as claimed. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In this case, there is no disclosure whatsoever is Fusselman as to a wavelength-changing fluorescent material, but rather, reference is made only to a colorant. Accordingly, anticipation is expressly precluded.

Claims 9-11 and 13-19 stand rejected under 35 U.S.C. §103(a) over Nagai et al. (‘394) or Sala et al. (‘946). The Examiner concedes that “there are no suggestions to combine the backing layer and the color layer into one layer in the Nagai or Sala reference.” That should end the argument right there, since the Examiner is essentially admitting that the burden of meeting *prima facie* obviousness has not been established. Nevertheless, the Examiner states that it would have been “obvious to one having ordinary skill in the art ... to have combined the backing layer and the color layer into one layer

motivated by the desire to obtain the maximize [sic] the glowing of the fluorescent material in daylight because the fluorescent material is visible through the transparent backing and is thereby affective to convert invisible rays of light into visible rays of light." Apart from this statement being difficult to understand, it assumes things about Applicants' invention, and the teachings of the prior art, which appear to be misguided. First of all, since the teachings of Nagai et al. and Sala et al. both reside in a fluorescent material which is *transferred* from a backing layer onto a page, how could it possibly be obvious to combine the fluorescent material with the backing material? Not only are these fluorescent materials meant to be transferred to a page, they are extremely thin, such that one no longer wishing to take advantage of highlighting, can simply rub them away. Thus, as with the Fusselman reference, these patents have to do with a thin highlighter, and have nothing to do with a tape with an edge that becomes visibly apparent or glows so that a user can find it. Indeed, according to Nagai et al. and Sala et al., it appears that the backing material simply gets re-rolled, such that a tear never occurs. And as far as a tear which occurs in the fluorescent layer, this happens on the page of a document itself, such that edge finding is not the issue. In fact, whereas Applicants wish for their tape to be as transparent as possible when overlaid onto a substrate, with only the edge glowing, the teachings of the prior art are just the opposite, namely, that the face area of the tape glows to form a highlighting function, about which Applicants are not concerned.

With regard to claim 10, the Examiner seems to be fabricating the assumption that the backing and adhesive layers of Nagai et al. or Sala et al. are also transparent, without any support for such a conclusion. With regard to claims 14 and 17, again, the Examiner assumes that the fluorescent material of Nagai et al. or Sala et al. would "inherently" exhibit the same optical density as claimed by the present invention. Where does the Examiner find support for these conclusions? The Examiner states

that it would have been obvious to have altered the amount of fluorescent materials, since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering an optimum or workable range involves only routine skill, citing In re Aller. However, the general conditions of Applicants' claims are not disclosed in the prior art, and the optimum or workable ranges for an edge that glows are entirely different from the optimum or working ranges for a highlighting tape. Thus, these inventions are mutually exclusive from that of Applicants, and the holding of In re Aller does not apply.

Claim 12 stands rejected under 35 U.S.C. §103 over Fusselman or Nagai et al. or Sala et al. and further in view of Argy et al. ('830). It is well settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicants' claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there is no teaching whatsoever from the prior art in support in of the combinations proposed by the Examiner, the fact that the Examiner essentially concedes throughout the Office Action.

Whereas Fusselman uses a colorant, and Nagai and Sala use a transferable fluorescent thin film, why would it be obvious to import the teachings of Argy et al., which has to do with revealing impacts received by a substrate such as a metal structure which would otherwise not be visible to the naked eye.

There is no question that prima facie obviousness has not been established.

OK to drop

Based upon the comments, all claims continue to be in condition for allowance. Questions regarding this application can be directed to Applicants' below-signed representative at the telephone/facsimile numbers provided.

Respectfully submitted,

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Date: April 1, 2002

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Box Issue Fee, Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: 4-1-02


Sheryl L. Hammer